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Attorney Reference Number 4239-56467-01
Application Number 09/700,999

ON THE UNITED STATES PATENT AND TRADEMARK OFFICE

re application of: Stephen M. Wiener et al.

Application No.: 09/700,999

Filed: December 4, 2000

Confirmation No.: 4557

For: METHOD FOR PRESSURE MEDIATED
SELECTIVE DELIVERY OF
THERAPEUTIC SUBSTANCES AND
CANNULA

Examiner: Nicholas D. Lucchesi

Art Unit: 3761

Attorney Reference No.: 4239-56467-01

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CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service as Express Mail Label No. EV514212661US in an envelope addressed to: MAIL STOP PETITIONS, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on the date shown below.

Stephen M. Wiener

Date of Deposit: January 17, 2008

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

The above-identified patent application became abandoned for failure to file a timely and proper response to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the date after the expiration date of the period set for reply to the Office notice or action plus any extensions of time actually obtained.

Applicant hereby petitions for revival of this application.

A reply to the above-noted Office action is in the form of a divisional application filed concurrently herewith (see MPEP § 711.03(c)(II)(A)(2)(a)).

Since this utility application was filed on or after June 8, 1995, no terminal disclaimer is required.

Enclosed is a check in the amount of \$1,540.00 for payment of the petition fee.

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The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. In support of this statement, it is submitted that:

Applicant requests that U.S. Application No. 09/700,999 be revived solely for purposes of establishing co-pendency with a divisional application filed concurrently herewith. Through inadvertence, the divisional application was not filed prior to abandonment of the present application.

This patent application is owned by the Government of the United States of America, as represented by the Secretary of the Department of Health and Human Services. The invention was made at the National Institutes of Health (NIH), and prosecution of the application is managed by the Office of Technology Transfer (OTT) at the NIH ("NIH/OTT"). The NIH was represented by Klarquist Sparkman, LLP in the prosecution of the patent application.

A Restriction Requirement was mailed on November 10, 2005, by the U.S. Patent and Trademark Office to Klarquist Sparkman, LLP. The Restriction Requirement required restriction between:

Group I (claims 1-51, 57-60, and 77), drawn to a method for the delivery of therapeutic or diagnostic agents;

Group II (claims 52-56 and 78), drawn to a method of determining a threshold pressure for selective administration of therapeutic or diagnostic substances;

Group III (claims 61-69), drawn to an access device for targeted delivery of therapeutic or diagnostic agents;

Group IV (claim 70), drawn to a method of accessing an interior of a gall bladder; and

Group V (claims 71-76), drawn to a method of delivering a therapeutic or diagnostic agent to a selected portion of the liver.

An Amendment and Reply to Restriction Requirement mailed January 9, 2006, elected Group III, drawn to the device, in response to the restriction requirement.

A non-final Office action was mailed on April 9, 2007, by the U.S. Patent and Trademark Office to Klarquist Sparkman, LLP.

Around about mid-September 2007, Michael Shmilovich at the Office of Technology Transfer at the National Institutes of Health (NIH) discussed the non-final Office action with Dr. Stephen Wiener, a co-inventor of the subject patent application. Pursuant to this discussion, Mr. Shmilovich decided to not continue prosecution of the pending, non-withdrawn claims directed to the device. However, the cancelled and withdrawn claims directed to the non-elected methods were not considered. The possibility of filing a divisional application directed to the non-elected claims also was not considered. The Government, as represented by NIH/OTT, had no intent to abandon prosecution of the non-elected method claims.

On October 2, 2007, the NIH sent an email to Klarquist Sparkman that referenced its case E-196-1998/2-US-07 (a unique NIH identifier for U.S. Application No. 09/700,999) and stated “[p]lease allow this case to go abandoned through inaction.” On October 2, 2007, the NIH also sent to Klarquist Sparkman a “Work Order” that stated “Discontinue Prosecution. Cases(S) to be abandoned are: E-196-1998/2-US-07” in the Work Description section. The “s” after “Case” in the Work Order is a standard form phrase that addresses the situation in which more than one application is referenced in the Work Order; however the only application referenced in this work order was the unique NIH identifier for U.S. Application No. 09/700,999. The unique identifier that has been assigned to the concurrently filed divisional application in accordance with standard practices at NIH/OTT is E-196-1998/2-US-15.

No reply to the April 9, 2007, non-final Office action was filed by the October 9, 2007 six-month due date.

A Notice of Abandonment was mailed on November 28, 2007, by the U.S. Patent and Trademark Office.

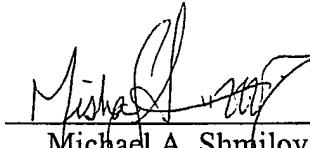
On December 17, 2007, the Notice of Abandonment was reported by Klarquist Sparkman to Mr. Shmilovich at NIH/OTT. Lili Portilla of the National Head, Lung and Blood Institute (NHLBI), which is part of the NIH, and Dr. Robert Hoyt, Jr., a co-inventor of the present application, were copied on the December 17th letter.

In early January 2008, following discussions with Dr. Hoyt and the NHLBI, it came to the attention of NIH/OTT that it had overlooked instructing its patent counsel to file a divisional patent application for this technology.

On January 8, 2008, Mr. Shmilovich contacted Klarquist Sparkman to inform them that the NIH had not intended to abandon the claims that had not been elected for prosecution in U.S. Application No. 09/700,999. Mr. Shmilovich noted that, through oversight, the NIH/OTT had not instructed its law firm to file a divisional application prior to abandonment of the parent application. Subsequently, on January 11, 2008, Mr. Shmilovich sent Klarquist Sparkman LLP instructions to file a divisional application and prepare this petition to revive the parent application solely for the purposes of establishing co-pendency with the divisional application. The claims to Group III that were prosecuted in the parent application are not present in the divisional application.

At no time during the pendency of U.S. Application No. 09/700,999, or any time since that application lapsed, did the assignee intend to abandon prosecution of claims to restriction groups that were not prosecuted in U.S. Application No. 09/700,999.

Respectfully submitted,

By:  January 17, 2008
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